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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,836	09/08/2003	Julien Lefebvre	2201.0010001/RWE	8398
26(1)	7590	03/30/2005		
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER	NAKARANI, DHIRAJLAL S
			ART UNIT	PAPER NUMBER
			1773	
DATE MAILED: 03/30/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/656,836	LEFEBVRE ET AL.
	Examiner	Art Unit
	D. S. Nakarani	1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 September 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 16-19 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-19 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 08 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/5/2005</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12 are, drawn to an adhesiveless masking film, classified in class 428, subclass 500<sup>+</sup>.
  - II. Claims 16-19 are, drawn to a method for measuring adhesion of a film, classified in class 73, subclass 150A<sup>+</sup>.
2. The inventions are distinct, each from the other because:
3. Invention I and II are independent and distinct from each other because the invention I is directed to an adhesiveless masking film while the invention II is directed to a method for measuring adhesion of a film. The method as claimed is not directed to measuring adhesion of claimed adhesiveless masking film.
4. Applicants are requested to NOTE that claims 13-15 are directed to a non-statutory subject matter therefore they are not grouped with either the claimed inventions I or II. In an event applicants amend these claims to direct them to statutory subject matter depending on amendment they will be restricted.
5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. During a telephone conversation with Robert Esmond on February 07, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 13-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Use of Mxsite<sup>TM</sup> in the manufacture of an adhesiveless masking

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film in claim 13 is a non-statutory subject matter. Use of an adhesiveless masking film to protect the surface of the substrate in claims 14 and 15 is a non-statutory subject matter.

11. Claim s 1-12 contains the trademark/trade name Mxsite<sup>TM</sup> in claim 1, lines 1 and 2; and in claim 5, line 2; Dow 494<sup>TM</sup> in claim 9, line 12 and Eastman Hifor<sup>TM</sup> in claim 9, line 3. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe Mxsite<sup>TM</sup> is used to describe a polyethylene cling resin, Dow 494<sup>TM</sup> is used to describe low density polyethylene and Eastman Hifor<sup>TM</sup> is used to describe linear low density polyethylene and, accordingly, the identification/description is indefinite.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The phrase "an advanced Zeigler Natta catalyzed" in claim 8, lines 2-3 and in claim 9, line 2, renders claims indefinite. Which Zeigler Natta catalyst is an advanced catalyst? Advanced compare to which Zeigler Natta catalyst?

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ghiam et al (U.S. Patent 6,326,081 B1) in view of Eichbauer (U.S. Patent 6,093,480).

Ghiam et al disclose a masking film comprising first layer having smooth surface and made of metallocene catalyzed copolymer of ethylene with a comonomer octene, hexene or butene and a second layer having rough surface and made of homopolymer or copolymer of olefins preferably polyethylene (col. 4 lines 45-60 and claims 1 and 5). Ghiam et al also suggest a multilayer structure that is with core layer having on one side the first layer and on second side the second layer. Ghiam et al fail to disclose specific polymer composition of the core layer and the second layer.

Eichbauer discloses a stretch wrap film having one layer made of polyethylene having cling property such as linear low density polyethylene made using single site or constrained geometry catalyst (i.e. metallocene catalyst) (col. 3 line 30 to col. 6 line 18). Eichbauer also

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suggest a multilayer film having a core layer i.e., inner layer and one or both side of the inner layer having cling property. The composition of inner layer is same as claimed in the instant invention. Eichbauer discloses a multi-layer film having one outer layer with cling property (A or D layers) and another outer layer with slip property (E layer). The polymer for inner layer include a blend of polyethylene cling resin and low density polyethylene or vary low density polyethylene or linear low density polyethylene (col. 6 lines 31-51). The polymers for the layer with slip property are polyethylene, polypropylene or combination thereof (col. 7 lines 4-22).

Therefore it would have been obvious to a person of ordinary skill in the art at the time of this invention made to utilize disclosure of Eichbauer in the invention of Ghiam et al to make inner layer i.e., core layer and the second layer of polymer taught by Eichbauer for the inner layer and for the slip layer.

No claims are allowed.

16. Receipt of Information Disclosure Statement filed January 5, 2005 is acknowledged and had been made of record.

17. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Canada on September 6, 2002. It is noted, however, that applicant has not filed a certified copy of the 2,401,794 application as required by 35 U.S.C. 119(b).

18. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119 (e) as follows:

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19. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence(s) of the specification or in an application data sheet by identifying the prior application by application number (37 CFR 1.78(a)(2) and (a)(5)). If the prior application is a non-provisional application, the specific reference must also include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. S. Nakarani/af  
March 24, 2005

  
**D. S. NAKARANI**  
**PRIMARY EXAMINER**